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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,095	10/25/2001	Roger J. Talish	41482/205545	3454

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CHIEF PATENT COUNSEL
SMITH & NEPHEW, INC.
1450 BROOKS ROAD
MEMPHIS, TN 38116

EXAMINER

CHAN, KO HUNG

ART UNIT PAPER NUMBER

3632

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,095

Applicant(s)

TALISH ET AL.

Examiner

Korie H. Chan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 3-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,13-15,18,19 is/are rejected.
- 7) ☒ Claim(s) 16,17,20-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/25/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of figures 6-7, claims 1, 2, 13-23 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that examiner's indication that there is no generic claim was in error. This is not found persuasive because applicant's argument to the existence of generic claim cannot be grounds for withdrawing a restriction/election requirement. Since, applicant did not traverse on the grounds that the species are not patentably distinct or burdensome for the examiner to search and examine, the restriction/election requirement stands.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3-12 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the clamp feature in combination with the elected embodiment of figures 6-7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show "rancho cube" as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Asman'870. Asman'870 discloses an apparatus comprising an adjustable clamp assembly (5 and 6, fig. 1), an holder having a shaft (8) extending from a cap (light socket 10), an adjustable connector being a barrel (21 and 22) receiving the shaft (8) of the holder, wherein the shaft is adjustable relative to the barrel, and the adjustable connector further comprises a handle (9) on the shaft.

Applicant's intended usage of a transducer holder interpreted as holder for a transducer for attachment to orthopedic appliance are not accorded with patentable weight.

Claims 1, 2, 13, 14, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Rome'038. Rome discloses an apparatus comprising an adjustable

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clamp (7), an adjustable connector comprising a barrel (8) receiving a shaft (4) extending from a cap or holder (2), and a coil spring (6) urging the holder (2) away from the connector (8).

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Perlitz'955. Perlitz disclose an apparatus comprising an adjustable clamp (20), a transducer holder (26) adapted to secure transducer (16), an adjustable connector (34) adapted to adjustably connect the clamp to the transducer holder, wherein the transducer holder is adjustable (via 34 and its respective screw sliding along slot 35).

Applicant's intended usage for securing to an orthopedic appliance is not accorded with patentable weight.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Ryaby et al'006. Ryaby disclose an apparatus comprising an adjustable clamp (Col. 5, lines 20-25), a transducer holder (5) adapted to secure transducer (8), an adjustable connector (33) adapted to adjustably connect the clamp to the transducer holder, wherein the transducer holder is adjustable (via telescoping connector).

Claims 16, 17, and 20-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Korie H. Chan whose telephone number is 703-305-8079. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Les Braun can be reached on 703-308-2156. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Korie H. Chan
Primary Examiner
Art Unit 3632

khc
February 24, 2003